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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID J. LADD

Appeal 2009-000757
Application 09/248,077¹
Technology Center 2400

Decided: August 26, 2009

Before LEE E. BARRETT, JAY P. LUCAS, and STEPHEN C. SIU,
Administrative Patent Judges.

BARRETT, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the rejection of claims 12-16, 27-30, 35-39, and 42-59. Claims 1-11, 17-26, 31-34, 40, and 41 have been canceled. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

We affirm.

¹ Filed February 10, 1999, titled "System and Method for Transmission and Delivery of Travel Instructions to Informational Appliances." The real party in interest is Avaya Technology Corp.

STATEMENT OF THE CASE

The invention

The invention relates to a system and method for delivering requested information, such as driving directions, to a user's wireless informational device or voice mailbox.

The background describes that an individual often needs information at times when it is difficult to access or when the individual is not in a position to record the information. For example, a driver in his car may become lost and need driving directions. Even if the driver contacts a person with needed directions, the driver would have to record such directions manually or rely on his memory, either of which can be difficult when the directions are complex. Spec. 1.

In the invention, a user can place a voice call to a call center using his wireless portable unit (e.g., a cellular telephone), conveying an information request (e.g., a starting location and a final destination for which directions are required) and the user's paging service or voice mailbox identification information. The call center enters the information request into an informational database (e.g., a mapping database) which generates text formatted information (e.g., text formatted directions). The text formatted information is processed with a text-to-voice processor to generate an audio representation of the information, which is transmitted to a paging network or voice mailbox identified by the user. Spec. 3-4.

The user no longer needs to record (e.g., transcribe the directions to paper) while driving or memorize the driving instructions. "Rather by the

claimed invention, the driving directions are stored in the user's voice mailbox, and the user can easily call that voice mailbox (often by pressing a single button on their cell phone or a simple voice command) and retrieve the driving directions whenever, and as often as, needed during the course of the trip." Br. 4.²

The claims

Representative claim 12 is reproduced below:

12. A method for communicating with a voice mailbox comprising the steps of:

receiving an information request and voice mailbox identification information, in the form of a telephone number corresponding to the user's voice mail system, from a wireless portable unit;

accessing an informational database with said information request;

receiving from the informational database, text format information in response to said information request;

processing said text format information with a text-to-voice processor to generate an audio representation of said text format information; and

transmitting said audio representation to a voice mailbox identified by said voice mailbox identification information, wherein the voice mailbox is remote from the wireless portable unit.

² We refer to the Second Supplemental Brief received January 16, 2008, as "Br." As noted by Appellant, the Examiner has twice reopened prosecution after a previous Appeal Brief was filed. Br. 1-2.

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The references

Craddock	US 6,351,771 B1	Feb. 26, 2002 (filed Mar. 12, 1998)
Bruce	US 6,765,998 B2	Jul. 20, 2004 (effective filing date Jul. 14, 1998)

The rejection

Claims 12-16, 27-30, 35-39, and 42-59 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bruce and Craddock.

The Examiner finds that Bruce teaches receiving an information request, accessing an informational database with the information request, receiving text formatted information from the database, and processing the text formatted information with a text-to-voice processor. Final Rej. 3. The Examiner finds that Bruce is silent about transmitting the audio representation to a voice mailbox identified by voice mailbox identification information, although the Examiner notes that Bruce teaches that the caller may receive the information in various ways, including voice mail message. *Id.* at 3-4. The Examiner finds that Craddock teaches converting text to a voice mailbox remote from the wireless portable device. *Id.* The Examiner concludes that it would have been obvious to transmit a voice message to a voice mailbox in Bruce as taught by Craddock. *Id.* at 4.

PRINCIPLES OF LAW

"[T]he test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). A rejection under 35 U.S.C.

§ 103(a) is based on the following factual determinations: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of non-obviousness. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)). Whether there is motivation to combine or modify the references is a question of fact drawing on the factors of *Graham*. See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). "[H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

FINDINGS OF FACT

Content of the references

Bruce

Bruce describes a method and system for providing information assistance, such as driving directions from a starting location to a destination location. The caller places a telephone call to access the system. The calling party's calling location (start location) may be automatically identified using automatic number identification ("ANI") to index a directory listing database or Name, Address and Telephone Database ("NATD") without requiring a caller to manually identify his location.

Col. 6, ll. 14-65. Mobile telephone locations may also be determined by known methods. Col. 6, l. 66 to col. 7, l. 45.

The calls may be handled by a live operator, e.g., col. 4, or by an automated interactive voice response system. Cols. 8-9.

In response to the information request, such as driving directions, the system consults an informational database, such as map routing software like Mapquest. Col. 8, l. 65, to col. 9, l. 21.

The map routing application software generates text route instructions in a format that is human or machine readable. The text route instructions can then be transmitted to the operator console to allow the operator to view and relay the route instructions to the caller. Col. 9, ll. 52-57.

Bruce describes:

The caller may receive the driving or route instructions in a variety of different ways. The route instructions can be communicated directly over the telephone from an interactive voice response system, a live operator, a synthesized voice, a voice mail message, and Internet electronic mail, an alpha/numeric pager or telephone or a Personal Digital Assistant ("PDA").

Col. 2, ll. 61-67 (emphasis added). (The Examiner mistakenly finds that this teaching is found at col. 3, ll. 30-45. Ans. 13.) *See also* Col. 9, ll. 58-59 ("The mapped route and step-by-step driving instructions can be conveyed to callers in a variety of different ways.").

Bruce describes that "the step-by-step travel directions can be retrieved by a human operator and relayed to a caller by having the human operator read the directions over the telephone to the caller." Col. 9,

ll. 60-63. Callers may download the route instructions to a computing device. Col. 10, ll. 6-11.

Bruce also describes receiving the travel directions using an interactive user interface system. Text instructions are transferred to an audio box 28 "which can then provide an interactive user interface to communicate the route instructions over the telephone." Col. 10, ll. 20-21. "Preferably, the interactive user interface provides an interactive voice response system with speech recognition to implement an automated user interface to provide information to callers." Col. 10, ll. 27-30. "The interactive user interface communicates the driving instructions to the callers and provides callers the ability to: [pause and continue messages, back up to previous steps or messages, skip ahead to successive steps in the directions, etc.]." Col. 10, ll. 35-44. Directions are provided using speech synthesis. Col. 10, ll. 63-65.

Craddock

Craddock describes a distributed service network "which provides communications and other services to fixed, mobile and nomadic users. . . ." Col. 1, ll. 14-15.

Craddock describes that "there is preferably a personal agent defined for each user which accomplishes several tasks." Col. 8, ll. 47-48.

Craddock describes:

Specifically, the user can instruct their personal agent to perform a variety of tasks, ranging from the simple to the quite sophisticated. For example, the user can have defined that their

personal agent contact the above-mentioned stock quotation service once every hour to determine the current price of one or more stocks and, if the prices reach a certain price, to contact the user in a defined manner, such as by sending them an email, or paging them, *providing them with a synthesized voice message in a voice mailbox* or by contacting them on their analog cellular telephone.

Col. 8, l. 62 to col. 9, l. 4 (emphasis added).

Differences between the prior art and the subject matter of claim 1

Bruce describes that "[t]he route instructions can be communicated directly over the telephone from an interactive voice response system, a live operator, a synthesized voice, a voice mail message, and Internet electronic mail, an alpha/numeric pager or telephone or a Personal Digital Assistant ("PDA"), col. 2, ll. 61-67 (emphasis added), and therefore suggests that one way to communicate the requested information is by a voice mail message. The voice mail message is distinct from the interactive voice response system mentioned in the quote. It is known in the art that a "voice mailbox is remote from the wireless portable unit."

Thus, the difference between Bruce and the subject matter of representative claim 1 is that Bruce does not expressly describe "receiving . . . voice mailbox information, in the form of a telephone number corresponding to the user's voice mail system."

Level of ordinary skill in the art

The USPTO has no way to take testimony about the level of ordinary skill in the art. Guessing at the level of education and experience possessed

by a person of ordinary skill in the art is meaningless because it says nothing about what the hypothetical person of ordinary skill in the art would be expected to actually know. What is really important is how persons skilled in the art think and what approach to solving a problem immediately comes to mind. If an express finding is required, the level of ordinary skill in the art is evidenced by the references. *See In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978) ("the PTO usually must evaluate both the scope and content of the prior art and the level of ordinary skill solely on the cold words of the literature"); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (the Board did not err in adopting the approach that the level of skill in the art was best determined by the references of record).

A person of ordinary skill in the art has certain presumed qualities and knowledge. *First*, a person of ordinary skill in the art must be presumed to know something about the art apart from what the references expressly disclose. *See In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962). *Second*, "the hypothetical person of ordinary skill in the pertinent art is presumed to have the 'ability to select and utilize knowledge from other arts reasonably pertinent to [the] particular problem' to which the claimed invention is directed." *Cable Elec. Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025 (Fed. Cir. 1985). That is, skill in the art must be presumed. *See In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985). *Third*, a person of ordinary skill has ordinary creativity and is capable of making changes within his or her technical ability without an express teaching or suggestion in a reference. The obviousness "analysis need not seek out precise teachings directed to

the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.* at 421. *Fourth*, a person of ordinary skill is presumed to be able to solve known problems using ordinary skill. "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *Id.* at 420. Thus, "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue known options within his or her technical grasp." *Id.* at 421. Of course, it cannot be expected that every possible modification which would have been obvious to one of ordinary skill in the art will be implemented or written down to become prior art.

ISSUE

Has Appellant shown that the Examiner erred in concluding that the limitation "transmitting said audio representation to a voice mailbox identified by said voice mailbox identification information, wherein the voice mailbox is remote from the wireless portable unit," as recited in method claim 12, would have been obvious to one of ordinary skill in the art over the combination of Bruce and Craddock?

Method claims 36 and 49 contain similar limitations to claim 12 and thus will stand or fall together with claim 12. System claim 27 recites a corresponding limitation in apparatus format: "a transmitter for providing said responsive information in the voice format to a voice mailbox identified by said voice mailbox identification information, wherein the voice mailbox is remote from the wireless portable unit." System claims 44 and 55 contain similar limitations to claim 27. Accordingly, we conclude that claim 12 is representative of all independent claims. The dependent claims have not been separately argued and therefore stand or fall together with claim 12.

CONTENTIONS

Appellant argues that Bruce does not teach "transmitting said audio representation to a voice mailbox identified by said voice mailbox identification information, wherein the voice mailbox is remote from the wireless portable unit," as recited in claim 12. Br. 11. It is argued:

Bruce provides a temporary "voice mail message," referred to as an "interactive user interface," . . . , which supplies the driving directions to the user. The interactive interface allows the user to stop, start, pause, review and skip through step-by-step instructions "such that *the user can listen and record* the instructions or listen and pause the instructions while they are actually driving the route. See col. 3, lines 11-13.

Br. 12 (bolding omitted).

Appellant argues that the user in Bruce must remember or transcribe the instructions since the pause lasts only a few seconds. Br. 12.

Appellant argues:

There is no showing or suggestion in Bruce that the "voice mail message" would be stored in a voice mailbox. There is particularly no showing or suggestion in Bruce that the voice mailbox would correspond to a telephone number of a voice mail system associated with the person desiring travel directions. It is evident that the "voice mail message" of Bruce never leaves the operator system where it was generated, since the user always has the option of returning to the live operator by pressing the "0" key. . . . It is actually inherent, based upon this fact of the Bruce disclosure, that the message is not being recorded into the voice mailbox corresponding to the telephone number of the caller's voicemail service.

Br. 13.

Appellant argues that after the caller hangs up in Bruce, there appears to be no way of returning to the travel directions without having to go through the process anew. Br. 13.

Appellant argues that Craddock does not show sending an audio representation to a voice mailbox. It is argued that while an agent can notify the user that a condition has occurred, the contents of this notification are not disclosed, and "Craddock in no manner suggests that an audio representation of text format information should be sent to a voice mailbox."

Br. 14.

Appellant argues that "[a]t most the combination of Craddock and Bruce would suggest that the user of the Bruce system should receive a voice mail notification that some condition has occurred; however, such notification would not have any bearing on the audio travel directions being transmitted to the caller." Br. 14.

The Examiner responds that Craddock describes that "a subscriber requests text data such as stocks where the text data would be provided in a synthesized voice message in a voice mailbox." Ans. 14-15.

Appellant replies that Craddock teaches that a user can be notified when a predetermined event occurs, but "Craddock is silent as to the form that the notification will take and provides no suggestion that the notification should comprise a synthesized voice reading text data." Reply Br. 2.

Appellant argues for the first time in the Reply Brief that a proper reason for modifying Bruce has not been provided. It is argued that the background of Bruce suggests that the purpose of the invention is to provide immediate assistance to drivers who are lost and to avoid keeping a live operator on the line, the service of Bruce provides a recording so that the driver can pause or replay the information. Reply Br. 2-3. It is argued that "neither Bruce nor Craddock is directed to obtaining information at a user's leisure." *Id.* at 3. It is further argued that "nothing in Bruce or Craddock explains how the modified Bruce system will place a telephone call to a user's voice mail box since Bruce only discloses a system for receiving telephone calls." *Id.*

ANALYSIS

Bruce describes that "[t]he route instructions can be communicated directly over the telephone from an interactive voice response system, a live operator, a synthesized voice, a voice mail message, and Internet electronic mail, an alpha/numeric pager or telephone or a Personal Digital Assistant

("PDA"). Col. 2, ll. 61-67 (emphasis added). These are all separate techniques, some of which involve communicating with the caller directly (interactive voice response, live operator, synthesized voice) and some indirectly (Internet electronic mail, an alpha/numeric pager or telephone or a Personal Digital Assistant). In particular, the "voice mail message" and "alphanumeric pager or telephone" are distinct from the "interactive voice response system." Although Bruce does not further describe the "voice mail message" or "alphanumeric pager or telephone" options, one of ordinary skill in the art knew what these were. A person skilled in the art has sufficient skill to know how to send the text in Bruce as text to "Internet electronic mail, an alpha/numeric pager or telephone or a Personal Digital Assistant," and to send the synthesized speech in Bruce as a "voice mail message." Therefore, Bruce expressly describes communicating the requested information by a voice mail message, which must be stored in a voice mailbox. It was known in the art that a "voice mailbox is remote from the wireless portable unit." To the extent there is any question that one of ordinary skill in the art knew how to send a text message by voice mailbox, Craddock describes an agent providing a user "with a synthesized voice message in a voice mailbox." Col. 9, ll. 2-3.

Appellant's argument that the "voice mail message" corresponds to the "interactive user interface" is not correct. The cited portion of Bruce at column 2, clearly distinguishes the method of a "voice mail message" from the "interactive voice response system." Thus, Appellant's arguments that

the interactive user interface does not meet the claim limitation because the caller must remain connected to the system is not persuasive.

The difference between Bruce and the subject matter of representative claim 1 is that Bruce does not describe "receiving . . . voice mailbox identification information, in the form of a telephone number corresponding to the user's voice mail system." However, one of ordinary skill in the art would have known that in order to send directions by "a voice mail message, and Internet electronic mail, an alpha/numeric pager or telephone or a Personal Digital Assistant," i.e., by a method other than by directly communicating with the caller, it would be necessary to receive the contact information (voice mailbox telephone number, e-mail address, alphanumeric pager or telephone number, or PDA address) from the caller. We conclude that one of ordinary skill in the art would have been motivated, from the need for a telephone number to store a voice mail message, to require a caller to provide a voice mailbox telephone number in Bruce.

CONCLUSION

Appellant has not shown that the Examiner erred in concluding that the limitation "transmitting said audio representation to a voice mailbox identified by said voice mailbox identification information, wherein the voice mailbox is remote from the wireless portable unit," as recited in method claim 12, would have been obvious to one of ordinary skill in the art over the combination of Bruce and Craddock. The rejection of representative claim 1, and its dependent claims 13-16 and 35, is affirmed.

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The rejection of independent claims 27, 36, 44, 49, and 55, and their dependent claims 28-30, 37-43, 45-48, 50-54, and 56-59, are affirmed for the reasons discussed in connection with claim 12.

In summary, the rejection of claims 12-16, 27-30, 35-39, and 42-59 is affirmed.

Requests for extensions of time are governed by 37 C.F.R. § 1.136(b).
See 37 C.F.R. § 41.50(f).

AFFIRMED

rwk

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